

**REMARKS**

**INTRODUCTION**

In accordance with the foregoing, claims 1 and 5 have been cancelled. Claims 6-10 are pending and under consideration.

**CLAIM REJECTIONS – 112**

Claims 1 and 5 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement and the enablement requirement.

Claims 1 and 5 were further rejected under 35 USC 112, second paragraph, as being indefinite.

Claims 1 and 5 have been cancelled.

Withdrawal of the foregoing rejections is requested.

**CLAIM REJECTIONS – 103**

Claims 6-10 were rejected under 35 USC 103(a) as being unpatentable over Okamoto et al. (US 5,696,744) (hereinafter "Okamoto").

Claim 6 recites: "...if determined as a result of the comparison via the comparison unit that the amount of data recorded on the optical disc is below the reference value, moving a pickup to a periphery area and measuring a focus error, and if the measured focus error is below a constant value, detecting the optical disc as a fashion disc type having diameters of 8 cm."

The Office Action notes that to arrive at this feature of claim 6, the Examiner combined some of the embodiments discussed in Okamoto. The Examiner cited as rationale that because the methods were known, one of ordinary skill could have combined them with predictable results which would have improved the accuracy of the apparatus to detect an optical disc. This statement is respectfully traversed on the grounds that by considering the claim as a whole, the prior art does not teach the apparatus of claim 6. Specifically, it is respectfully submitted that it is not correct for the Examiner to merely focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves or individually are obvious. See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). See also *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) ([P]rior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention... Moreover, appellants

cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention.").

In the present case, it is respectfully submitted that claim 6 provides an apparatus for detecting a disc that patentably distinguishes over the prior art because although some of the techniques may have been known, their combination to produce a more accurate disc detecting apparatus was not known. Indeed, the Office Action notes that the apparatus recited in claim 6 introduces redundant checks, which improves accuracy over the prior art.

Claims 7-10 depend on claim 6 and are therefore believed to be allowable for at least the foregoing reasons.

Withdrawal of the foregoing rejection is requested.

#### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Gregory W. Harper  
Gregory W. Harper  
Registration No. 55,248

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501